

Application Serial No. 10/507,535
Attorney Docket No. 10191/3836
Reply to Office Action of February 4, 2009

REMARKS

Claims 30 to 33 are added, claim 17 is canceled without prejudice, and therefore claims 16 and 18 to 33 are now pending in the present application.

In view of the following, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

As to the Examiner Interviews of December 11, 2008, December 15, 2008, and January 15, 2009, Applicant thanks the Examiner for the interviews with Elizabeth Tretter (a legal assistant with Kenyon), and for reissuing a new NONFINAL Office Action on February 4, 2009, since the Office erroneously rejected the present application based on claims 1 to 15, which were canceled by the Preliminary Amendment filed on December 13, 2004, but which was apparently not earlier considered.

Applicant respectfully requests that the Examiner acknowledge all claims for foreign priority and officially accept the drawings.

Claims 16 to 29 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent 6,611,201 ("Bishop" reference).

As to the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. *See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the claimed subject matter of the claims, as discussed herein. *See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art." M.P.E.P. § 2112; *See Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'l. 1990). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish

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the inherency of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine is not sustainable absent the foregoing conditions.

While the rejections may not be agreed with, to facilitate matters, claims 16, 21, 25, 28, and 29 have been rewritten. In particular, claims 16, 25, 28 and 29 now include the features of claim 17, which has been canceled without prejudice.

As to claim 16, as presented, the text at col. 16, lines 12-16, of Bishop merely refers to a system in which recall notifications are sent to the vehicle unit if the vehicle or a part of the vehicle is being recalled by the manufacturer. Thus, the occupant will only receive a notification or message in the unlikely and seldom event that a recall actually occurs. The presently claimed subject matter, however, allows for the self-monitoring of engine characteristic curves and operating data, so as to allow for a determination of when the components of the engine are no longer in compliance with a maximum allowable limit or manufacturer's warranty. This is not identically disclosed (or even suggested) by the Bishop reference as applied. With the presently claimed subject matter, the occupant will therefore be alerted upon the presence of any defective component that is no longer operating within an allowable range. This superior safety benefit is simply not provided for in the Bishop system. Claim 16 also includes the feature in which the command sequence monitors a plurality of engine characteristics, and is therefore allowable for this further reason, since this feature is not identically disclosed (nor even suggested) by the applied reference.

Claim 16, as presented, is therefore allowable, as are its dependent claims 18 to 24.

As further regards claim 21, as presented, it further provides that the command sequence is checked for plausibility in the processing unit, and is therefore allowable for this further reason, since the applied reference does not identically disclose (nor even suggest) this feature.

Claims 25, 28, and 29 include features like those of claim 16, as presented, and are therefore allowable for essentially the same reasons.

New claims 30 to 33 do not add any new matter and are supported by the present application, including the specification. Claims 30 to 33 depend from claims 29, 16, 25 and 28 and are therefore allowable for the same reasons as their respective base claim.

Accordingly, claims 16 and 18 to 33 are allowable.

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CONCLUSION

In view of the above, it is respectfully submitted that all of presently pending claims 16 and 18 to 33 are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. Since all issues raised by the Examiner have been addressed, an early and favorable action on the merits is respectfully requested.

Date: 4/30/2009

Respectfully submitted,

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